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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,153	01/12/2000	Rodney H. Masters	P01506US2	5245

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EXAMINER

YIP, WINNIE S

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 08/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/481,153

Applicant(s)

MASTERS ET AL.

Examiner

Winnie Yip

Art Unit

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 7-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35 U.S.Code not included in this application can be found in a prior office action.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 4, 2002 has been entered.

Claim Rejection/ 35 U.S.C. 251

3. Claims 7-12 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent can not be recaptured by the filing of the present reissue application.

In this case, the changing the recited limitation from "said apparatus is" to "said grating sheets are" (claim 7, lines 15), from "said system is" to "said grating sheets are" (claim 15, lines

16), and newly recited "said grating sheets are" (claim 18) broadens aspect in the reissue claims as relating to subject matter previously surrendered.

Notice, to overcome the rejection, applicant should amend the claims as originally claimed but clarifies the claims 16-17 and 20 which are rejected under 35 U.S.C. 112 as set forth the office action mailed July 17, 2001 since the "grating sheet" and the "threaded member" may be made of two different types of corrosion resistant materials as described in the specification. The specification as originally filed does not define both of the "securing mechanism" (the fasteners 20, 30, 40) and the grating sheet being made of same type of corrosion resistant material of either stainless steel or fiberglass as recited in claims 16-17 and 20.

Claim Rejections - 35 USC § 102

4. Claims 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by documents C or E of AIMS of the information disclosure statement filed 07/07/2000.

AIMS teaches, Document C or E, a fastening system comprising: a fiberglass grating sheet being made of corrosion resistant material such as fiberglass and being capably secured to a structure support of an offshore platform in an wave zone area, a plate fastener (see options I and II), a top plate, a bottom plate being sized and shaped for attaching to the structural support members of the offshore platform in a laterally extending direction to support the grating sheet, a threaded member (stud) secured on the bottom plate and extending between the top and the bottom plates and through an opening of the top plate, such that by fastening a nut on a recessed top surface of the top plate from a position on a top surface of the grating sheet, the grating sheet is clamped together and secured between the top and bottom plates.

Claim Rejections - 35 USC § 103

5. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable AIMS Document D of AIMS in view of Document C of AIMS of the information disclosure statement filed 07/07/2000.

AIMS teaches, Document D (Detail 1 and Sections A, B), a fastening system comprising: a fiberglass grating sheet being made of corrosion resistant material such as fiberglass and being secured to a structure support of an offshore platform in an wave zone area, elongated a L-shaped connectors (the "claim"/the retainer angle) being sized and shaped to be attached to the structural support members of the offshore platform in a laterally extending direction for clamping the longitudinal edges of the grating sheet to the structural support member, and plate fasteners (see Section of Wavezone Bracket Detail) having a top plate for mounting on an upper surface of the grating sheet, a lower plate secured on other edges of the offshore platform in a laterally extending direction, and a threaded portion extending between the top and bottom plates and through openings in the top and bottom plates for engagement with a nut for clamping the grating sheet on the structure support members. Although Document D does not teaches the threaded member being secured only from a position on a top surface of the grating sheet as claimed. However, AIMS teaches, Document C, a fastening system comprising a fastening plate having the threaded member (the stud) mounted on the lower plate and extending upwardly through the opening in the top plate for engagement with a nut on a top surface such that the threaded member being fastened only from a position on the top surface of the grating sheet for securing the grating sheet on the structure support. It would have been obvious to one ordinary skill in the art modify the fastening system of Document D of AIMS having the threaded members mounted on the lower plate and extending upwardly through an opening in the top plate to receive a nut to the upper

surface of the grating sheet as taught of Document C of AIMS for the purpose of easily securing the grating sheet to the structure support member from the top surface of the grating sheet which solves the same problem as the claimed invention.

6. Claims 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Document D or Document C in view of Document D of AIMS for the same reasons set for the office action mailed March 21, 2001.

Allowable Subject Matter

7. Claims 7-14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 251 set forth in this Office action.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not teach an apparatus having securing mechanism extending between an upper surface of a top plate and an opening of a bottom plate for clamping the top and bottom plates and the grating sheet together only from a position on a top surface of the grating sheet in arrangement as claimed.

Response to Amendment

9. Applicant's arguments filed July 22, 2002 and January 4, 2002 have been fully considered but they are not deemed to be persuasive.

In response to applicant's argument to claims 18-21 that the lower plate of the Document C (or E) is not attached to the structural member and can only be positioned into place from underneath the grating sheet, a recitation of the intended use of the claimed invention must

result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, claims 18-21, applicant only claims an apparatus for securing a grating sheet to a structural member, but does not positively recite the grating sheet and the structural members such as the offshore platform. Therefore, the environment of the offshore platform is not considered to be part of the claimed invention. And, the lower plate of the apparatus of Document C or E is considered would be capably laterally secured to the structure support member before fastening the grating sheet, therefore, the threaded member of Document C can only be tied by the nut in position on the top surface of the grating sheet as claimed as similar to applicant's embodiment shown in Fig. 8.

In regard to claims 15-17, Document C is only used as a reference to teach one ordinary skill in the art to modify the Document D having the threaded member being secured on the lower plate for claiming the grating sheet to the structure support member in a position from the top surface of the grating sheet as taught by Document C as discussion set forth above rejection.


Therefore, the rejections are deemed proper.

Inquiry Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 703-308-2491. The examiner can normally be reached on M-F (9:30-6:30), Second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Winnie Yip
Examiner
Art Unit 3637

wsy
August 27, 2002